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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/659,977  | 09/11/2003  | Eric L. Barsness     | ROC920030288US1             | 5062             |
| 46797 7590 03/08/2007<br>IBM CORPORATION, INTELLECTUAL PROPERTY LAW<br>DEPT 917, BLDG. 006-1<br>3605 HIGHWAY 52 NORTH<br>ROCHESTER, MN 55901-7829 |             |                      | EXAMINER<br>ZURITA, JAMES H |                  |
|   |             |                      | ART UNIT                    | PAPER NUMBER     |
|   |             |                      | 3625                        |                  |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 03/08/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/659,977

Applicant(s)

BARNES ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-25 and 39-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-25, 39-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

On 11 September 2003 applicant filed this application, without claims to priority.

On 17 March 2005, the application was published as PG-PUB 20050060237A1.

On 8 June 2006, the Examiner issued a restriction requirement.

On 10 July 2006, applicant elected claims 18-25, cancelled claims 1-17, 26-38, and added claims 39-54. New claims 39-54 are parallel media and environment claims.

On 18 September, the Examiner rejected Claim 18-23, 39-44 and 47-52 under 35 U.S.C. 102(e) as anticipated by Solomon (US PG-PUB US 20040162638 A1) and claims 24-25, 45-46 and 53-54 under 35 U.S.C. 103(a) as unpatentable over Solomon in view of Wu (PG-PUB 20050038708).

### ***Response to Amendment***

Applicant's submission of 18 December 2006 has been entered.

Applicant amended claims 18, 39 and 47. Claims 18-25 and 39-54 are pending.

Claims 18, 39 and 47 were amended to include the limitation "...corresponding to the identified grid computing resource..."

### ***Response to Arguments***

Objections to the Drawings are withdrawn in view of amendment.

Objections to the Specification are withdrawn in view of amendment.

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Applicant's arguments filed 11 September 2006 have been fully considered but they are not persuasive. Applicant argues,

...As an initial matter, Applicants note that the Examiner's rejection relies on disparate portions of Solomon having no apparent/explicit relationship. If, after review of the present submission, the Examiner disagrees, Applicants kindly request that the Examiner elaborate on the relationship between these disparate portions in order to move prosecution forward...[page 10]

In response, Applicants are reminded that patents and applications are written by and for skilled artisans. See *Vivid Technologies Inc. v. American Science and Engineering, Inc.* 200F.3d 795, 804, 53 USPQ2nd 1289, 1295 (Fed. Cir. 1999). The examiner has presumed that Applicant is a skilled artisan who possesses at least ordinary skill in the art. Consequently, it is the Examiner's position that because the references of record are directed to those with ordinary skill in the art, these references are clear, explicit and specific as to what they teach.

Nevertheless, some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, applicants are hereby given actual notice that if after reasonably reading any reference of record, whether the reference is currently of record or subsequently made of record, if applicants can not reasonably understand or if applicant have difficulty comprehending one or more sentences, statements, diagrams or principles set forth in one or more of the references of record, applicants should, in their next appropriately filed response, bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with

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37 CFR 1.111(b), applicants response must also state why they either do not understand or have difficulty with the references.

Applicant also argues, page 9,

...[the new limitation, introduced 18 December 2006] was already at least implicit since the original claims recited that the requests were submitted to appropriate grid resources "according to the respective different resource specific criterions". Accordingly, the amendment neither narrows the claim nor introduces new matter; and, as result, Applicants are entitled to a full range of equivalents. Page 10, emphasis added.

In response, the Examiner notes that during prosecution, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

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Applicant appears to rely on a single paragraph (from a total of over 400 paragraphs) to argue,

...In this case, Solomon does not disclose "each and every element as set forth in the claim". For example, regarding claim 18, Solomon does not disclose "receiving, from a requesting entity, a plurality of requests related to a benchmarking operation". The Examiner argues that Solomon discloses this element at paragraph [0068]. However, the cited passage is in fact directed to how a swarm (e.g., of ants) forms. No reference to a benchmarking operation, or anything capable of being construed as a benchmarking operation, is disclosed *in this portion* of Solomon. Further, no computer implemented method comprising a step of receiving a plurality of requests related to a benchmarking operation is disclosed. Accordingly, the rejection is believed to be defective and Applicants respectfully request that the rejection be withdrawn. [page 10, emphasis added]

In response, the Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner. The Examiner also respectfully directs applicant to other portions of Solomon, including, for example, paragraphs 0095, 0332 and 0375 which refer to option selection methods and developing benchmarks to select simulations.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 18-23, 39-44 and 47-52** are rejected under 35 U.S.C. 102(e) as being anticipated by Solomon (US PG-PUB US 20040162638 A1).

**As per claim 18**, Solomon discloses computer-implemented method of providing access to grid computing resources available to a plurality of users, comprising:

receiving, from a requesting entity, a plurality of requests related to a benchmarking operation (as in paragraph 0068, for example), wherein

- at least one of the requests comprises a defined function to be performed (see, for example, at least paragraph 0069) and
- at least each of the remaining requests comprise a different resource specific criterion identifying a different specific resource to perform the defined function (as in paragraph 0341, for example);

based on each resource specific criterion, identifying a grid computing resource as the specific resource to perform the defined function (see, for example, at least paragraph 0365) wherein a different grid computing resource is identified for each different resource specific criterion (for example, paragraph 0365 notes specific location criteria); and

submitting each request to perform the defined function to an appropriate grid resource corresponding to the identified grid computing resource [new limitation] according to the respective different resource specific criteria (as in paragraphs 0315, and 365 for example).

**As per claim 19**, Solomon discloses that each different resource specific criterion uniquely identifies a different particular computer and wherein identifying the

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grid computing resource comprises identifying the particular computer (see, for example, at least paragraph 0365).

**As per claim 20**, Solomon discloses that each different resource specific criterion uniquely identifies different particular computer hardware and wherein identifying the grid computing resource comprises identifying a particular computer having the particular computer hardware (see, for example, at least paragraph 0027)

**As per claim 21**, Solomon discloses that each different resource specific criterion uniquely identifies different particular computer software and wherein identifying the grid computing resource comprises identifying a particular computer having the particular computer software (see, for example, combination of hardware and software agents, as in paragraph 0310).

**As per claim 22**, Solomon discloses that each different resource specific criterion is selected from one of an operating system criterion, a central processing unit criterion, a memory criterion, a hard disk criterion and a combination thereof (see, for example, at least paragraph 0084).

**As per claim 23**, Solomon discloses performing the defined function using the identified grid computing resource; and returning a result to the requesting entity indicating performance of the defined function (see, for example, references to results, as in paragraph 0032).

Claim 39 is rejected on the same grounds as claim 18.

Claim 40 is rejected on the same grounds as claim 19.

Claim 41 is rejected on the same grounds as claim 20.



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Claim 42 is rejected on the same grounds as claim 21.

Claim 43 is rejected on the same grounds as claim 22.

Claim 44 is rejected on the same grounds as claim 23.

Claim 47 is rejected on the same grounds as claim 18.

Claim 48 is rejected on the same grounds as claim 19.

Claim 49 is rejected on the same grounds as claim 20.

Claim 50 is rejected on the same grounds as claim 21.

Claim 51 is rejected on the same grounds as claim 22.

Claim 52 is rejected on the same grounds as claim 23.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claims 24-25, 45-46 and 53-54*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon in view of Wu (PG-PUB 20050038708).

Solomon does not explicitly disclose determining a price to be charged for fulfilling the requests (claim 24) and charging the price for fulfilling the request (claim 25). These limitations are disclosed by WU, as in paragraph 0024, for example.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Solomon and Wu to disclose determining a price to be charged for fulfilling the requests (claim 24) and charging the price for fulfilling the request (claim 25).

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One of ordinary skill in the art at the time the invention was made would have been motivated to combine Solomon and Wu to disclose determining a price to be charged for fulfilling the requests (claim 24) and charging the price for fulfilling the request (claim 25) for the obvious reason that businesses need to charge money for their services and products in order to stay in business.

Claim 45 is rejected on the same grounds as claim 24.

Claim 46 is rejected on the same grounds as claim 25.

Claim 53 is rejected on the same grounds as claim 24.

Claim 54 is rejected on the same grounds as claim 25.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**James Zurita**  
**Primary Examiner**  
**Art Unit 3625**  
3 March 2006



**JAMES ZURITA**  
**PRIMARY EXAMINER**